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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053501
Party	Defendant Del Taco, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK TRIAL AND APPEAL BOARD**

CHRISTIAN M. ZIEBARTH,

Petitioner,

vs.

DEL TACO LLC

Respondent.

Reg. No. 1,043,729

Cancellation No. 92053501

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**RESPONDENT DEL TACO LLC'S REPLY BRIEF IN SUPPORT OF MOTION TO COMPEL UNDER  
RULE 2.120(E) AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO  
ADMISSION REQUESTS UNDER RULE 2.120(H)**

Despite Petitioner Christian Ziebarth's scattershot approach in his Opposition to Respondent Del Taco LLC's ("Del Taco") Motion, Petitioner has failed to demonstrate how the information and documents requested in Respondent's discovery requests are *not* discoverable under the Trademark Rules of Practice and the Federal Rules of Civil Procedure. The reason for this is simple: the documents and information sought by Del Taco are discoverable because they are both relevant and reasonably calculated to lead to the discovery of admissible evidence regarding not only Petitioner's claims but also several potential defenses that Del Taco may bring in this proceeding. Accordingly, Petitioner should be ordered to serve full, complete, and proper responses to Interrogatories 1-15, Document Requests 1-26, and Admission Requests Nos. 1-72.

Petitioner devotes most of his Opposition and supporting exhibits to unnecessary and irrelevant arguments as to his alleged standing, the alleged abandonment of the subject NAUGLES mark by Del Taco, bombastic allegations that Del Taco's discovery requests are a fishing expedition

for so called “confidential information” from a future “competitor,”<sup>1</sup> and even allegations of a lack of good faith on the part of Del Taco.<sup>2</sup> Petitioner’s actual arguments against production can be summarized as follows: (1) Del Taco has failed to *prove* a defense of lack of standing or unclean hands; (2) Del Taco has not alleged any claim or defense that would justify production; (3) Del Taco has not cited a single case featuring an identical fact pattern to the current action; and (4) Del Taco’s argument that production could justify a defense of unclean hands is irrelevant because if Petitioner does not have standing then the case would be disposed of entirely. As set forth below, these arguments patently fail and even serve to demonstrate the discoverability and relevance of the information and documents sought by Del Taco in this proceeding.

First, contrary to Petitioner’s suggestion, Del Taco is ***not*** required to prove how it will use the requested information and documents in order to have discovery of such items. Nor is Del Taco required to specifically plead each and every claim or defense that could ***theoretically*** be made in order to obtain discovery in a proceeding. Such requirements as would be imposed by Petitioner are not only contrary to the entire purpose of discovery, but are expressly disfavored by both the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) which require claims to be plead with enough detail to give the other side fair notice of the basis for the defense. See TBMP § 311.02(b); Federal Rules of Civil Procedure 8 and 9.

Petitioner next argues that it should not have to produce the documents and information requested because Del Taco has not set forth in its Motion any equitable defenses aside from unclean hands, which he dismisses as ***unproven*** by Petitioner. Opposition, pp. 15-16. However, as

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<sup>1</sup> Even if Petitioner’s statement in this regard were relevant to Del Taco’s Motion to Compel, any concerns he has as to confidentiality have been provided for in the Standard Protective Order issued by the Board and agreed upon by the parties to govern this proceeding.

<sup>2</sup> Contrary to Petitioner’s interpretation, Petitioner’s August 21, 2011 letter, attached as Exhibit 6 to Del Taco’s Motion, left no room for further discussions regarding the dispute between the parties. See Exhibit 6. Thus, Del Taco had no choice but to file the instant Motion after waiting nearly two months for the deficient responses from Petitioner and receiving such a conclusive response.

Petitioner himself notes (*see* Opposition, pp. 11-12), it is entirely possible that the information and documents requested by Del Taco could give rise to not only a claim of unclean hands, but also fraud on the Trademark Office. Again, Del Taco stresses that these equitable defenses cannot be plead unless done so citing the *specific conduct* that constitutes the basis for the defense. *See* Federal Rules of Civil Procedure 8 and 9; TBMP 311.02(b); *see also Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ 2d 1701 (Fed. Cir. 1992); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ 2d 1067 (TTAB 1987); *Heisch v. Katy Bishop Productions Inc.*, 45 USPQ 2d 1219 (N.D. Ill. 1997). Therefore, discovery of the requested documents and information in this proceeding is necessary **before** Del Taco can determine and then plead the appropriate defenses that are available to it. Petitioner's suggestion otherwise is not only illogical, but also completely unfounded and in contravention with the Federal Rules and the Trademark Rules of Practice.

To next try to justify Petitioner's refusal to sufficiently respond, Petitioner engages in an extensive dissection of each case cited in footnotes of cited sections in the TBMP and in Del Taco's Motion to conclude that because no case cited or referenced by Del Taco has an identical fact pattern to the instant action, Del Taco's Motion should be denied.<sup>3</sup> Opposition pp. 7-8. Petitioner further suggests that the basic rules of discovery, as set forth in the TBMP and the Federal Rules of Civil Procedure, are not applicable to Del Taco's discovery requests because all of the "cases cited in the footnote" consist of "oppositions and a cancellation action that are all based on the ground of likelihood of confusion." Opposition, p. 9. According to Petitioner, if no cases cited in a footnote

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<sup>3</sup> Petitioner does so while only citing to a single highly distinguishable case in support. However, as even admitted by Petitioner, the *Nirvana, Inc. v. Nirvana For Health Inc.*, 2010 TTAB LEXIS 432 (TTAB Dec. 1, 2010) (not precedential) case did not involve any claims or defenses involving the validity of the petitioner's mark. *Id.*; *see also* Opposition, p. 8. In fact, the respondent in that case did not even file any briefs or evidence at trial. *Nirvana*, 2010 TTAB LEXIS at \*5. Thus, the case is highly distinguishable from the matter at hand and is not persuasive as to the relevance or discoverability of the information and documents sought by Del Taco.

of the TBMP consist of the same proceeding and claims as the instant action, then the provisions of that section of the TBMP do not apply. By Petitioner's interpretation then, the provisions of TBMP § 414(2) governing the use of representative samples for unduly burdensome productions would not apply to cancellation proceedings *at all* because all of the cases cited in the footnote only involve opposition proceedings. See TBMP § 414(2), note 2. This is simply not the case.

Moreover, contrary to the suggestion of Petitioner, the Board *has* previously recognized a petitioner's lack of standing as a valid defense to a cancellation proceeding where the petitioner did not have a lack of *bona fide* intent to use the mark at the time of filing an application. See *British-American Tobacco Co. Ltd v. Phillip Morris USA, Inc.*, 2004 TTAB Lexis 472 at \*21-22 (TTAB August 4, 2004) (not precedential) (recognizing right of registrant to challenge validity of an intent-to-use application pleaded by petitioner in cancellation proceeding); *A.V. Brands, Inc. v. Spritis Intn't*, 2009 TTAB Lexis 199 at \*13-23 (TTAB March 31, 2009) (not precedential) (examining whether petitioner had standing in cancellation proceeding where respondent challenged the validity of petitioner's intent-to-use application); *see also Frank Salacuse v. Ginger Spirits, Inc.*, 44 USPQ 2d 1415 (TTAB 1997) (upholding defense of lack of bona fide intent to use raised by respondent as valid defense in cancellation proceeding). As the *British-American* case recognized, a challenge to an intent-to-use application pleaded by a petitioner in a cancellation proceeding goes to the standing of the plaintiff, a "threshold inquiry" in the proceeding. *British-American Tobacco*, 2004 TTAB Lexis at \*21-22. Therefore, the Board has repeatedly recognized a defense of lack of standing by virtue of a lack of *bona fide* intent to use an applied-for mark in a cancellation proceeding.

In a final, desperate attempt to avoid production, Petitioner next engages in circular logic to claim that if he does not have standing, then the fact that he could also have unclean hands is immaterial because the case would be dismissed for lack of standing. Opposition, p. 13. Petitioner

concludes that it should not have to produce the documents and information requested by Del Taco because Del Taco would not “need” to “allege an equitable defense of unclean hands” and the discovery requests are therefore irrelevant and not calculated to lead to the discovery of admissible evidence. (*Id.*)

This perplexing argument would require Del Taco to prove an entire defense based on the actions of **Petitioner** without ever seeing the requested documents and information. Moreover, it actually serves to demonstrate that the information and documents sought by Del Taco are discoverable as the discovery requests admittedly relate to an issue, *i.e.* standing, that could **dispose of the case entirely**. See Opposition, p. 13 (“[T]hen Petitioner would lack standing and the cancellation action would be **dismissed**”) (emphasis added). Therefore, Petitioner’s own argument against responding in fact justifies production.

Accordingly, the foregoing arguments and those contained in Del Taco’s initial Motion fully demonstrate that the information and documents sought by Del Taco are discoverable as they are relevant and reasonably calculated to lead to the discovery of admissible evidence under the Trademark Rules of Practice and the Federal Rules of Civil Procedure. Del Taco respectfully requests that an order be issued compelling Petitioner Christian Ziebarth to serve full, complete, and proper responses to Interrogatories 1-15, Document Requests 1-26, and Admission Requests Nos. 1-72.

Dated: December 2, 2011

  
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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a copy of the foregoing was sent by first-class mail, on this 2nd day of December, 2011, to Susan M. Natland and Gregory Phillips, Knobbe Martens Olson & Bear LLP, 2040 Main Street, 14th Floor, Irvine, California 92614, Susan.Natland@kmob.com and Gregory.Phillips@kmob.com.

  
April L. Besl